



#11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Gerlovin, et al.
Serial Number : 09/316, 549
Filed : May 24, 1999
For : INTEGRATION OF AN ANALYSIS INTO THE
FEATURES OF A MODEL OF AN OBJECT
Group Art Unit : 2123
Examiner : Jones, Hugh
Paper Number :

Docket Number : PAS-093

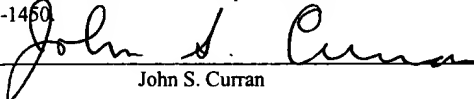
**PETITION TO WITHDRAW HOLDING OF ABANDONMENT
PURSUANT TO 37 C.F.R. 1.181(a) and MPEP 711.03(c)I**

CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR 1.10

"Express Mail" Mailing Label Number EV 244 882 392 US

Date of Deposit June 3, 2003

I hereby certify that this transmittal letter and the papers referred to as being enclosed therein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.


John S. Curran

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the official Notice of Abandonment mailed April 7, 2003, and in accordance with 37 C.F.R. 1.181(a) and MPEP 711.03(c)I, Applicants request that the holding of abandonment of this application be withdrawn for the reasons stated below. A copy of the Notice of Abandonment mailed April 7, 2003 (**Attachment P1**), along with other supporting documents, are included for your review.

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On January 29, 2003, Applicants filed a submission (**Attachment P2**) via first class mail which included: Response (3 pages); Pro/Intralink Documentation Release 3.0 (CD ROM); Pro/Engineer 2000i Documentation (CD ROM); Pro/Engineer 2000i Collection of Help Topics English and European Languages (CD ROM); Pro/Engineer 2000i Part Modeling Topic Collection (PDF); Printout of Pro Engineer Part Modeling Users Guide Release 20.0 Table of Contents and Chapter 3 (84 pages); and a Postcard , copies of which are provided herewith as **Attachment P2**, that was responsive to a Requirement for Information mailed November 29, 2002 a copy of which is provided herewith as **Attachment P3**.

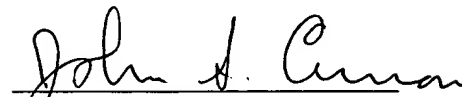
The January 29th submission was received and date stamped by the PTO on February 3rd, 2003. A copy of the stamped postcard is provided herewith as **Attachment P4**. Subsequently, Applicants received a Notice of Abandonment (**Attachment P1**) mailed April 7, 2003 which indicated that the reason for abandonment was that no reply to the November 29, 2002 Requirement for Information had been received by the Patent Office.

The United States Patent & Trademark Office appears to have made a clerical error by losing or misplacing Applicant's timely-filed response to the November 29, 2003 Requirement for Information. Sometime between the date stamping of the postcard by the Patent Office and the subsequent Notice of Abandonment, Applicant's response vanished while in the Patent Office's control. Accordingly, since the Abandonment was caused by the Patent Office's clerical mistake, Applicants hereby petition, pursuant to 37 C.F.R. 1.181(a) and MPEP 711.03(c)I, to withdraw the holding of abandonment based on (the alleged) failure of the Applicants to respond to the Requirement for Information Office Action of November 29, 2002.

In the event, this petition is granted, please forward the attachment P2 to the Examiner for his consideration. If there are any outstanding issues concerning this application, please contact Applicants' Attorney as identified below.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

A handwritten signature in cursive script, appearing to read "John S. Curran", written over a horizontal line.

By: John S. Curran

Reg. No. 50, 445

Attorney for Applicants

28 State Street
Boston, MA 02109-1784
Tel: (617) 227-7400
Fax: (617) 742-4214

Date: June 3, 2003

P 1

PRG



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,549	05/24/1999	EMMANUEL GERLOVIN	PAS-093	7946

959 7590 04/07/2003

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109



EXAMINER

JONES, HUGH M

ART UNIT PAPER NUMBER

2123

DATE MAILED: 04/07/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

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	LAHIVE & COCKFIELD
	DOCKET DEPT.
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RETRIEVED: <i>Mac</i>	
FORWARDED: <i>110</i>	

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P1 p24

Notice of Abandonment

Application No.
09/316,549

Applicant(s)
Gerlovin et al.

Examiner
Hugh Jones

Art Unit
2123



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on Nov 29, 2002.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113(a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted issue fee of \$ _____ is insufficient. A balance of \$ _____ is due.

The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d) is \$ _____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed new formal drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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HUGH JONES
PRIMARY EXAMINER
ART UNIT 2123

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

LAHIVE

&

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L L P

COUNSELLORS AT LAW

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Technology Center 2100

January 29, 2003

Commissioner for Patents
Box Non-Fee Amendment
Washington, D.C. 20231

Re: U.S. Patent Application Serial No. 09/316,549
Title: "INTEGRATION OF AN ANALYSIS INTO THE FEATURES OF A MODEL
OF AN OBJECT"
Inventors: Emmanuel Gerlovin et al.
Filing Date: May 24, 1999
Attorney Docket No. PAS-093

Dear Sir:

I enclose herewith for filing in the above-identified application the following:

1. Response (3 pages);
2. Pro/Intralink Documentation Release 3.0 (CD ROM);
3. Pro/Engineer 2000i Documentation (CD ROM);
4. Pro/Engineer 2000i Collection of Help Topics English and European Languages (CD ROM);
5. Pro/Engineer 2000i Part Modeling Topic Collection (PDF);
6. Printout of Pro Engineer Part Modeling Users Guide Release 20.0 Table of Contents and Chapter 3 (84 pages); and
7. Postcard

Please charge any necessary fees to our Deposit Account No. 12-0080. The undersigned requests any extensions of time necessary to respond. *A duplicate of this sheet is enclosed.*

Certificate of First Class Mailing (37 CFR 1.8(a))

I hereby certify that this transmittal letter and the papers referred to as being enclosed therein are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box Non-Fee Amendment, Washington, D.C. 20231 on:

January 29, 2003

Date

John S. Curran

John S. Curran, Esq.

Reg. No. 50,445

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

By:

John S. Curran

John S. Curran, Esq.
Registration No. 50,445
Attorney for Applicant



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,549	05/24/1999	EMMANUEL GERLOVIN	PAS-093	7946

959 7590 11/29/2002

LAHIVE & COCKFIELD
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EXAMINER	
JONES, HUGH M	
ART UNIT	PAPER NUMBER
2123	

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

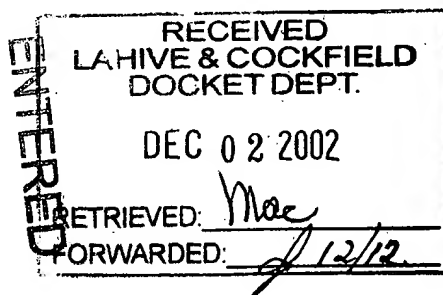
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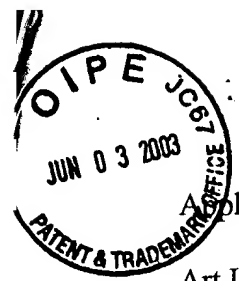
Jan 29, 2003 RESPONSE DUE
May 28, 2003 ESP

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P3

Application/Control Number: 09/316,549

Page 2

Art Unit: 2123

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DETAILED ACTION

Introduction

1. Claims 1-33 of U. S. Application 09/316,549 filed on 24-May, 1999, are presented for examination. Applicants were asked to supply documents *material to the patentability of the claims* (paper # 3, paragraphs 7-9). Applicants respond (paper # 6) that providing the software packages is "based on the incorrect belief that Applicant attempted to incorporate Pro/Engineer by Reference". This is an inaccurate statement relating to the request for information (see paragraphs 7-9, paper # 3). Therefore, please note the following Requirement for Information under 37 C.F.R. 1.105.

Requirement for Information - 37 C.F.R. § 1.105

2. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:

- Pro/Engineer 2000i: The Examiner requires user's manuals for "Pro/ENGINEER 2000i" which Applicants refer to in the specification (lines 11-13):

"The illustrative embodiment of the present invention is realized as part of a CAD/CAM package, such as Pro/ENGINEER 2000i, which is sold by Parametric Technology Corporation of Waltham, Massachusetts. The illustrative embodiment provides the ability to integrate an analysis into a future-based model."

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- Pro/Engineer: The Examiner also requires user's manuals for "Pro/ENGINEER" which has been developed by the current assignee and which appears to disclose the claimed invention (Applicants refer to Pro/Engineer in the IDS - paper # 5). The Examiner notes that Parametric Technology Corporation is the assignee for the instant application.

- Pro/Intralink: The Examiner also requires user's manuals for "*Pro/Intralink*", which has been developed by the current assignee and which appears to disclose the claimed invention. The Examiner notes that Parametric Technology Corporation is the assignee for the instant application.

3. The information is required to enter in the record the art suggested by the applicant as relevant to this examination in the specification (lines 11-13, page 4):

- user's manuals for Pro/Engineer 2000i (as well as earlier versions): Applicants refer to "Pro/ENGINEER 2000i" in the specification (lines 11-13):

"The illustrative embodiment of the present invention is realized as part of a CAD/CAM package, such as Pro/ENGINEER 2000i, which is sold by Parametric Technology Corporation of Waltham, Massachusetts. The illustrative embodiment provides the ability to integrate an analysis into a feature-based model."

4. In response to this requirement, please provide a complete copy of each of the following items of art referred to in the specification (lines 11-13, page 4) and the Information Disclosure Statement (paper # 5):

- user's manuals for Pro/Engineer 2000i (as well as earlier versions): Applicants refer to "Pro/ENGINEER 2000i" in the specification (lines 11-13):

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“The illustrative embodiment of the present invention is realized as part of a CAD/CAM package, such as Pro/ENGINEER 2000i, which is sold by Parametric Technology Corporation of Waltham, Massachusetts. The illustrative embodiment provides the ability to integrate an analysis into a feture-based model.”

- Pro/Engineer; see item “A6”, paper # 5 (IDS).

5. For the reasons provided, the commercially available *user’s manuals* for “*Pro/Engineer*” and “*Pro/Intralink*” are considered especially relevant to the instant application and should be submitted to the Examiner for consideration. The text accompanying the Pro/Engineer 2000i reference provides a short description which indicates that the listed reference, is considered very relevant and appears to be *essential* to the instant invention and claims, and therefore the applicant is required to provide the office with copies of the references for consideration. The Examiner requires the user’s manuals, which have already been made available to the public, because the Examiner needs to consider them in so far as they *appear to be material to the patentability of the application as per 37 C.F.R. 1.56*. It is also noted that Applicants have *already* provided three pages from the Pro/Engineer Part Modeling User’s Guide from Parametric Technology Corporation. The Examiner requires the *entire* document.

6. **The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement.** This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information

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disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

7. **The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56.** Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item. Applicants are reminded that they have referred to the material in the specification and have relied upon the material in a declaration in order to attempt to traverse 112(1) rejections.

8. **This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months.** EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

9. **Any inquiry concerning this communication and any earlier communications from the examiner should be:**

directed to: Dr. Hugh Jones telephone number (703) 305-0023, Monday-Thursday 0830 to 0700 ET, *or* the examiner's supervisor, Kevin Teska, telephone number (703) 305-9704. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, telephone number (703) 305-3900.

mailed to: Commissioner of Patents and Trademarks
Washington, D.C. 20231

P3

Application/Control Number: 09/316,549

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Art Unit: 2123

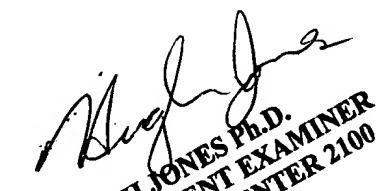
or faxed to: (703) 308-9051 (for formal communications intended for entry) *or*
(703) 308-1396 (for informal or draft communications, please label "*PROPOSED*"
or "*DRAFT*").

Dr. Hugh Jones

Primary Patent Examiner

November 26, 2002


KEVIN J. TESKA
SUPERVISORY
PATENT EXAMINER


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100

P4



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Office No. PAS-093

**THE "RECEIVED" STAMP OF THE PATENT AND TRADEMARK OFFICE
IMPRINTED HEREON ACKNOWLEDGES THE FILING OF:**

Description of Paper* and No.: Transmittal letter (1 page) (in duplicate); Response (3 pages); Pro/Intralink Documentation Release 3.0 (CD ROM); Pro/Engineer 2000i Documentation (CD ROM); Pro/Engineer 2000i Collection of Help Topics English and European Languages (CD ROM); Pro/Engineer 2000i Part Modeling Topic Collection (PDF); Printout of Pro Engineer Part Modeling Users Guide Release 20.0 Table of Contents and Chapter 3(84 pages); and this return postcard.

Title: Integration of An Analysis Into the Features of a Model of an Object

Name of Applicant(s): Emmanuel Gerlovin, et al.

Intf. or Serial No.: 09/316,549

Atty: John S. Curran (TVS/KJC)

Date: January 29, 2003

*with Certificate of First Class Mailing

